

Applicant : Kevin J. Tracey et al.  
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wherein R and R<sub>1</sub> are independently hydrogen, sulfamide, carboxyamide, cyano, straight or branched C<sub>1-6</sub> alkyl, straight or branched C<sub>2-6</sub> alkynyl, straight or branched C<sub>1-6</sub> alkoxy, a straight chain C<sub>1-6</sub> alkyl or a straight chain C<sub>2-6</sub> alkenyl having an ether link or an ester link, toluenyl, COOH, nitrate, or halide (Br, Cl, I, F), wherein at least one of R and R<sub>1</sub> is COOH, wherein R<sub>2</sub> and R<sub>3</sub> are independently hydrogen, sulfamide, carboxyamide, cyano, straight or branched C<sub>1-6</sub> alkyl, straight or branched C<sub>2-6</sub> alkynyl, straight or branched C<sub>1-6</sub> alkoxy, a straight chain C<sub>1-6</sub> alkyl or a straight chain C<sub>2-6</sub> alkenyl having an ether link or an ester link, toluenyl, COOH, nitrate, or halide (Br, Cl, I, F).

#### Remarks

Claims 1, 5 - 21, and 28 - 35 were pending in this application. Claims 5 - 21 and 29 - 35 are allowed, and claims 1 and 28 stand rejected. With this amendment, applicants cancel claim 30 and amend claims 1 and 28 to more particularly point out and distinctly claim the invention. Specifically, claim 1 and 28 are amended to correct spelling errors. Additionally, claim 28 is amended to eliminate the last two limitations of the claim, which are inconsistent with the requirement therein that at least one of R and R<sub>1</sub> is COOH. Claim 30 is also cancelled because the sole limitation therein, that at least one of R and R<sub>1</sub> is COOH, is already a limitation of claim 28, to which claim 30 is dependent.

#### Rejection under 35 U.S.C. 112, second paragraph

Claims 1 and 28 stand rejected under 35 U.S.C. 112, second paragraph. It is asserted that claim 28 requires the recitation of an anion, and that the spelling of "straight" and "branched" is incorrect. Applicants respectfully request reconsideration and withdrawal of this rejection based on the claim amendments and the following remarks.

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Regarding the incorrect spellings, claims 1 and 28 have been amended to make those corrections.

Regarding the requirement that claim 28 recites an anion, applicants assert that the language of the claim is not indefinite without the recitation of an anion. The preamble of the claim states, "An ischemia-damage mitigating compound or salt thereof, said compound having a formula I: . . . ." This language is clear that the claim recites a compound or its salt, wherein the compound has formula I. Unlike the previous claims that were rejected based on the lack the recitation of an anion, the claim does not recite, "The salt of a compound, having the formula . . . .", but the formula of claim 28 is that of the compound, while a salt of the compound is claimed. Additionally, the language of claim 1 similarly recites "An ischemia-damage mitigating salt of a compound, the compound having a formula I:", and it is recognized that claim 1 need not recite the anion.

Claim 28 is therefore analogous to claim 1, but it includes forms of the formula I compound that are not salts, such as the free base. The skilled artisan would understand that the free base is useful for manufacturing the salt (see, e.g., the synthesis of a free base of formula I at page 13, line 30 - page 14, line 2 of the specification), and can also be useful in pharmaceutical compositions.

Applicants would also like to point out that claim 28 has not been previously rejected under 35 U.S.C. 112, second paragraph, and no previous amendment to claim 28 would have necessitated the new rejection. Therefore, applicants believe that the Office Action should not have been made final.

#### Conclusion

In light of the claim amendments and discussion above, Applicants respectfully request withdrawal of the remaining rejection and passage of the claims as amended to

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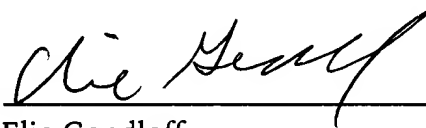
allowance. Should there be any additional matters that prevent allowance of the claims, the Examiner is urged to contact the undersigned attorney.

Applicants believe that no fee is required for this Amendment and Response. However, if any additional fee is required to preserve the pendency of this application, authorization is hereby given to charge the amount of any such fee to Deposit Account No. 01-1785.

Respectfully submitted,

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By:   
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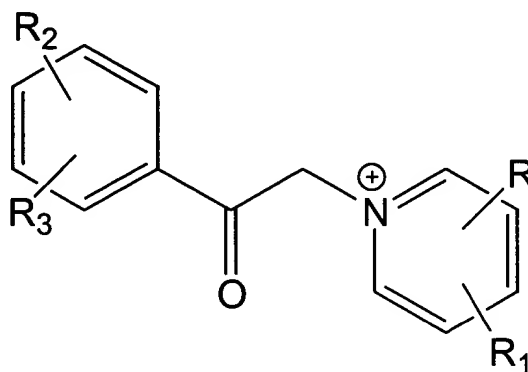
Appendix A

Marked Up Amended Claims - U.S. Patent Application 09/118,388

Additions are underlined and deletions are bracketed

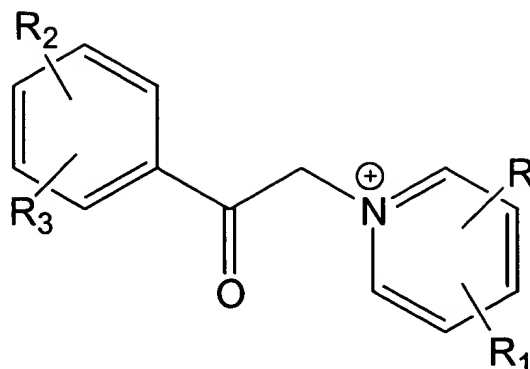
IN THE CLAIMS:

1. (Four times amended) An ischemia-damage mitigating salt of a compound, said compound having a formula I:



wherein R and R<sub>1</sub> are independently hydrogen, sulfamide, carboxyamide, cyano, straight or [brnched]branched C<sub>1-6</sub> alkyl, straight or branched C<sub>2-6</sub> alkynyl, straight or branched C<sub>1-6</sub> alkoxy, a [stright]straight chain C<sub>1-6</sub> alkyl or a straight chain C<sub>2-6</sub> alkenyl having an ether link or an ester link, toluenyl, COOH, nitrate, or halide (Br, Cl, I, F), wherein at least one of R and R<sub>1</sub> is COOH, wherein R<sub>2</sub> and R<sub>3</sub> are independently hydrogen, sulfamide, carboxyamide, cyano, straight or [brnched]branched C<sub>1-6</sub> alkyl, straight or branched C<sub>2-6</sub> alkynyl, straight or branched C<sub>1-6</sub> alkoxy, a [stright]straight chain C<sub>1-6</sub> alkyl, or a straight chain C<sub>2-6</sub> alkenyl having an ether link or an ester link, toluenyl, COOH, nitrate, or halide (Br, Cl, I, F).

28. An ischemia-damage mitigating compound or salt thereof, said compound having a formula I:



wherein R and R<sub>1</sub> are independently hydrogen, sulfamide, carboxyamide, cyano, straight or [brnched]branched C<sub>1-6</sub> alkyl, straight or branched C<sub>2-6</sub> alkynyl, straight or branched C<sub>1-6</sub> alkoxy, a [stright]straight chain C<sub>1-6</sub> alkyl or a straight chain C<sub>2-6</sub> alkenyl having an ether link or an ester link, toluenyl, COOH, nitrate, or halide (Br, Cl, I, F), wherein at least one of R and R<sub>1</sub> is COOH, wherein R<sub>2</sub> and R<sub>3</sub> are independently hydrogen, sulfamide, carboxyamide, cyano, straight or [brnched]branched C<sub>1-6</sub> alkyl, straight or branched C<sub>2-6</sub> alkynyl, straight or branched C<sub>1-6</sub> alkoxy, a [stright]straight chain C<sub>1-6</sub> alkyl or a straight chain C<sub>2-6</sub> alkenyl having an ether link or an ester link, toluenyl, COOH, nitrate, or halide (Br, Cl, I, F)[,

with the proviso that if either R or R<sub>1</sub> is CH<sub>3</sub>, the other is not H or CH<sub>3</sub>; and

with the further proviso that if either of R or R<sub>1</sub> is 2-methyl, the other is not 4-alkoxycarbonyl].